

Amendments to the Figures:

The attached sheet includes a change to Fig. 19. This sheet replaces the original sheet 17 that included Fig. 19 of the originally-submitted figures. In Fig. 19, the description of element 388 has been modified to now read "intersection". No new matter has been added.

Attachment:

Replacement Sheet

Annotated Sheet Showing Changes

REMARKS

Claim Status

The application as filed includes claims 1-92. In the present Amendment and Response, Applicants hereby amend claim 82 and add claims 93 and 94 to more distinctly point out the subject matter of the invention. Support for the amendment and new claims can be found throughout the originally-filed application, and at least at lines **4-14** on page **18** of the originally filed specification. Applicants also cancel claims 74-81, 91 and 92 without prejudice, and reserve the right to pursue these claims in related applications. Upon entry of this Response, claims 1-61, 63-73, 82-90, 93 and 94 will remain pending in this application.

Applicants note that due to administrative error, there is no claim 62 in the application.

Claim Rejections

In the Office action, claims 82, 83, and 85-90 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,343,271 by Peterson et al. (“Peterson”).

Claims 1-61, 68-81, 84 and 91-92 were rejected under 35 U.S.C. § 103(a) as unpatentably obvious in view of Peterson and in further view of U.S. Patent No. 6,922,810 to Trower II et al. (“Trower II”).

Rejections under §102(e)

Independent claim 82, as amended, recites, in part, “creating a log” that includes “records of the application of one or more provisions to one or more claims,” “aggregating the logged records across multiple provisions” and “analyzing the aggregated records to determine a statistical characteristic of the one or more provisions.”

Peterson is generally directed to “a claims processing system for electronically reviewing and adjudicating medical insurance claims.” Healthcare providers use the system to “electronically prepare and submit claims for payment.” The techniques

described by Peterson, however, end once the claim is paid. In contrast to Applicants' claimed invention, Peterson does not provide any post-application analysis of how specific provisions were applied to specific claims at an aggregated level. It is this very functionality, set forth in the claims but lacking in Peterson, that allows Applicants' system to provide useful information to companies offering healthcare plans – e.g., how often a particular provision is utilized by the plan participants, and how much it costs to offer. As a result, companies can eliminate costly, yet rarely used provisions of their benefit plans without adversely affecting the plan participants.

Thus, Applicants respectfully submit that Peterson does not teach or suggest every element of claim 82, and thus fails to anticipate claim 82. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 82 under 35 U.S.C. §102(e), as well as those claims that depend directly or indirectly therefrom.

Rejection of Claims 1-61 and 63-73 under §103(a)

To establish a case of *prima facie* obviousness, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, and not based on applicant's disclosure. See MPEP § 706.02(j). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would one impel one skilled in the art to do what the patent applicant has done. See MPEP §2145(X)(A).

As stated above, Peterson is generally directed to system for electronically reviewing and adjudicating medical insurance claims. Trower II is generally directed to a computer user interface which "allows users to input requests to various application or software modules executing on the computer" and provides the user with "a grammar-based automatic completion of the user input so far, and/or a grammar-based suggestion list of one or more possible options for completing the user input."

In that regard, Applicants respectfully submit that Peterson simply would not motivate one skilled in the art to use a context-free grammar to adjudicate healthcare claims, nor is there anything in Trower II that would suggest using the computer system described therein to process healthcare claims. First, as the Examiner recognizes, Peterson is silent with respect to any mention of a grammar-based adjudication approach. Trower II does not supply what Peterson lacks in this regard. Nowhere does Trower II teach or suggest using a context-free grammar to process healthcare claims, as recited in the present claims. The present inventors' recognition that there is a structure to health insurance agreements that can be rigidly and readably expressed in a context free grammar was a major innovation. Applicants' use of a context free grammar to adjudicate healthcare claims is neither taught nor made obvious by the prior art.

Moreover, a combination of the references, even if appropriate, would fail to produce essential features of the claimed invention. Independent claims 1 and 27 both recite, in relevant part, "determining whether the at least one provision applies to the claim" on the basis of "the received information corresponding to the context free grammar expression." As recognized by the Examiner, Peterson "does not explicitly teach a context-free grammar expression" and thus cannot, by extension, describe using a context-free grammar expression to adjudicate healthcare claims. Trower II does not cure this deficiency. As discussed above, Trower II describes "using a context free grammar to create an expression for input to a database information retrieval system" and nowhere contemplates or describes how such a system could be applied in a healthcare context.

Trower II describes no such determination, as it merely provides "automatic completion of the user input" that "determines a most likely completion option from the matching rules and a list of suggested completion options." See, Abstract and Col. 6 lines 1-3. Thus, even if a combination of Peterson and Trower II were proper, it would not teach or suggest the subject matter of independent claims 1 and 27. Trower's auto-completion mechanism for text fields and search engines is simply not germane to the applicability of a healthcare provision to a particular claim.

Thus, because neither Peterson or Trower II, alone or in combination, teaches or suggests every element of independent claims 1 and 27, Applicants respectfully submit that these references, alone or in combination, fail to render these claims obvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 and 27 under 35 U.S.C. §103(a), as well as those claims that depend directly or indirectly therefrom.

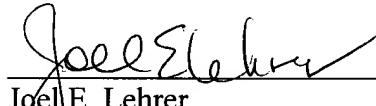
Rejection of Claims 74-81, 91 and 92 under §103(a)

Claims 74-81, 91 and 92 have been cancelled, and thus these rejections are rendered moot.

CONCLUSION

In view of the foregoing, Applicants respectfully requests reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1-61, 63-73, 82-90, 93 and 94 in due course. The Examiner is invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,


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